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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,139	04/20/2004	Steven W. Andrews	17543CON2 (AP)	5372

7590 06/30/2008
Robert J. Baran - T2-7H
Allergan, Inc.
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EXAMINER

ANDERSON, REBECCA L

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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06/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/829,139	Applicant(s) ANDREWS ET AL.	
	Examiner REBECCA L. ANDERSON	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 6,8-14 and 20-26 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 16-18 is/are allowed.
- 6) ☒ Claim(s) 2,3 and 7 is/are rejected.
- 7) ☒ Claim(s) 4,5,15,19 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-27 are currently pending in the instant application. Claims 1 and 16-18 appear allowable over the prior art of record. Claims 2, 3 and 7 are rejected. Claims 4, 5, 15, 19 and 27 are objected. Claims 6, 8-14 and 20-26 are withdrawn from consideration as being for non-elected subject matter.

Terminal Disclaimer

The terminal disclaimer filed on 5 April 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent No. 6,699,863 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Amendment and Arguments

Applicant's amendment filed 26 June 2008 and arguments filed 5 April 2007 have been fully considered and entered into the application. Applicants amendment and arguments have overcome the 35 USC 112 2nd paragraph rejections. Additionally, the terminal disclaimer filed has overcome the obviousness type double patenting rejection. While applicant states that the amendment to the claims deletes non-elected subject matter, it is noted that claims 4, 5 and newly added claim 27 still contain non-elected subject matter when R3 and R4 are other than forming together with the nitrogen atom a piperidiny ring.

Claim Objections

Claims 4, 5 and 15 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, claim 1 limits R3 and R4 to form a piperidinyl ring, however, dependent claim 4 has R4 and R4 together with the nitrogen atom, forming a 5 or 6 member ring and claim 5 has R3 and R4 also able to form a morpholinyl ring. Claim 15 limits claim 3 by stating that the compound is formula III, however, claim 3 and claim 1 from which it depends has already limited the formula to formula III.

Claim 19 is objected to because of the following informalities: Specifically, claim 19 does not end in a period. Appropriate correction is required.

Claims 15 and 19 are objected to as being dependent upon a rejected base claim.

Claims 4, 5 and 27 are objected to as containing non-elected subject matter. Specifically, claims 4, 5 and 27 have R3 and R4 as other than piperidinyl.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically claims 2 and 7 are drawn to products wherein the definition of R7 includes "(lower) alkyl-substituted derivatives". The term "derivatives" found in the claims is defined as a compound, usually organic obtained from another compound by a simple chemical process or a organic compound

containing a structural radical similar to that from which it is derived (Hackh's chemical dictionary, 1972). Therefore, the term "derivatives" found in the claims renders the claims indefinite because it is unclear what compounds are being claimed, i.e. what similar radical is found in the derivative and encompassed by the instant claims. It is suggested to overcome this rejection, applicant amend the claims to delete all instances of the term "derivative(s)" from the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/
Primary Examiner, AU 1626*

23 June 2008

Rebecca Anderson
Primary Examiner
Art Unit 1626, Group 1620
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